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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,974	08/20/2003	Wu Mei	241786US2SRD	4968
22850 7590 01/25/2007 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER LEE, CYNTHIA K	
			ART UNIT	PAPER NUMBER
			1745	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/25/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/643,974

Applicant(s)

MEI ET AL.

Examiner

Cynthia Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-7 and 20-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-7 and 20-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

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### ***Response to Amendment***

This Office Action is responsive to the amendment filed on 11/03/2006.

Claims 2 and 8-19 have been canceled and claims 20-32 have been added.

Claims 1, 3-7 and 20-32 are pending. Claims 1, 6, and 7 have been amended.

The Examiner notes that the 35 USC 102 rejection has been overcome.

However, upon further consideration, the instant claims are rejected under new grounds of rejections and thus claims 1, 3-7 and 20-32 are finally rejected for reasons necessitated by applicant's amendment.

### ***Claims Analysis***

The limitation "fuel cell" in the preamble of claim 1 was considered but has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. See MPEP 2111.02.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1, 3-7 and 20-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamauchi (JP 2002-226926) in view of Tsumura (US 2002/0015878).

Yamauchi discloses a catalyst material comprising chemical compounds X, Y, and Z. X (applicant's T) comprises Ti, Zr, Al, Fe, Cr, Mo, V, and Si. Y (Applicant's A) comprises Pt, Ag, Au, Cu, Ni, Pd, Co, Cr, Mo, W, Ti, Zr. The metallic elements are treated with a gaseous phase of ammonia (NH<sub>3</sub>) at an elevated temperature [0012]. Yamauchi discloses embodiments in which the elevated temperature range includes from ~500C to ~1500C. See Examples 1-3.

The X falls within the range between 0.0001 atom% and 70 atom% [0008] (applicant's claim 5). Should it not be disclosed with sufficient specificity, Yamauchi discloses that the function of the generated compound becomes remarkable when carrying out the addition of X of the solid more than 0.0001 atom%. However, if the addition of a metallic element X exceeds 70 atom%, it will become difficult to distribute a functional compound particle in a matrix [0008], thus clearly teaching that the atomic ratio of X is a result effective variable. It has been held by the courts that discovering an optimum value or workable ranges of a result-effective variable involves only routine skill in the art, and thus not novel. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). See MPEP 2144.05.

Example 5 [0027, 0028] discloses a Cu-Al solution that was held at 800 C in NH<sub>3</sub> atmosphere in 1 atm for 2 hours. It resulted in fine particles that are homogeneously dispersed, in which includes AlN dispersed in Cu matrix.

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Likewise, it would have been obvious to one of ordinary skill in the art at the time the invention was made to mix any one of X and Y compounds under the same experimental conditions as Example 5.

The Examiner notes that in the instant Specification pg. 15 lines 14-17 that nitriding is performed at a temperature of 200 C to 1000 C for 0.05 to 100 hours in a gas atmosphere containing NH<sub>3</sub> with a partial pressure of 0.05 atm or more.

Yamauchi must necessarily possess platinum-containing nitride particles because particles of Yamauchi are prepared by the method of the claims as supported in the Specification. The burden has been shifted to the applicant to show obvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983). It is noted that if the applicant intends to rely on Examples in the specification or in a submitted declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with the Yamauchi.

Yamauchi does not disclose the average diameter of the catalyst particles. However, Tsumura teaches that in conventional electrodes, a metal belonging to the platinum group is supported on a carbon and is used as a catalyst metal. The activity of such an electrode highly depends on the surface area of the catalyst metal. It can therefore be thought that catalytic activity may be enhanced by reducing the particle diameter of the catalyst metal to increase surface area per unit weight. However, it has been reported that as the particle

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diameter of the catalyst metal belonging to the platinum group decreases to below the range of 2.5 to 3.5 nm, the catalytic activity of the metal per unit weight decreases due to the particle size effect (see K. Kinoshita, J. Electrochem. Soc., 137, 845 (1990)). Consequently, the catalyst metals currently used are a platinum-group metal having a mean particle diameter of about from 2.5 to 4 nm and highly dispersedly supported on carbon particles. In order for such conventional electrodes to have sufficient properties in practical use as a cathode or an anode, the amount of the platinum-group metal supported on the cathode or the anode should be as large as 0.4 mg/cm.<sup>2</sup> or higher or 0.1 mg/cm.<sup>2</sup> or higher, respectively. In contrast, the electrodes of the invention are free from the particle size effect and show high activity even when the catalyst particle diameter is 1.5 nm or lower, preferably from 0.5 to 1.5 nm. Tsumura clearly teaches that the particle diameter is a result effective variable. It has been held by the courts that discovering an optimum value or workable ranges of a result-effective variable involves only routine skill in the art, and thus not novel. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). See MPEP 2144.05.

Yamauchi does not disclose a membrane electrode assembly (applicant's claim 6) or a fuel cell (applicant's claim 7) with catalytic layer as claimed by the applicants. However, Tsumura teaches a membrane electrode assembly comprising a solid polymer electrolyte film and a cathode and anode supported by collectors ([0077] and fig 2). To make an electrode, a mixture of carbon

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particles and cation-exchange resin was formed. The mixture was mixed in an aqueous solution of platinum [0079, 0080] (applicant's claims 6 and 7).

Although the catalyst metal may be an elemental metal belonging to the platinum group, it is preferably an alloy comprising one or more elements belonging to the platinum group. More preferably, the catalyst metal comprises platinum element and ruthenium element. Use of a catalyst metal comprising a metal element belonging to the platinum group is preferred in that this catalyst metal has high catalytic activity in electrochemical oxygen reduction reaction and hydrogen oxidation reaction. Furthermore, use of a catalyst metal comprising platinum element and ruthenium element is effective in giving an electrode which, when used in a fuel cell employing a reforming gas containing a slight amount of CO, is highly inhibited from being influenced by the CO [0026]. Furthermore, the catalyst metal preferably contains, in addition to platinum-group metals, at least one element selected from the group consisting of magnesium, aluminum, vanadium, chromium, manganese, iron, cobalt, nickel, copper, zinc, silver, and tungsten. This catalyst metal is advantageous in that the amount of a platinum-group metal used can be lowered and the catalyst metal can have satisfactory CO tolerance and high activity in oxygen reduction reaction [0027]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Yamauchi's catalyst particles in Tsumura's fuel cell because it has been held by the court that the selection of a known material based on its suitability for its intended use is *prima facie*

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obvious. *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). See MPEP 2144.07.

Further, Yamauchi discloses that this material is a hydrogen adsorption material [0033]. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Yamauchi's catalytic material in membrane electrode assemblies and fuel cells for the benefit of catalyzing hydrogen gas in the anode.

### ***Response to Arguments***

Applicant's arguments filed 11/3/2006 have been fully considered but they are not persuasive.

*Applicant asserts that Yamauchi does not suggest the platinum-containing nitride particles as recited in claims 1, 6, or 7 because Applicant asserts that Yamauchi simply suggests the composite material of a platinum matrix and nitride particles containing Ti, Zr, Al, Fe, Cr, Mo, V, or Si.*

Yamauchi must necessarily possess platinum-containing nitride particles because particles of Yamauchi are prepared by the method of the claims as supported in the Specification. The burden has been shifted to the applicant to show obvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983). It is noted that if the applicant intends to rely on Examples in the specification or in a submitted declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with the Yamauchi.



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The Examiner notes that although Yamauchi discloses that the X phase is dispersed on the matrix of metallic Y element, (abstract, [0028]), some particles will inherently contain nitride particles with platinum because the instant specification pg 11, starting line 24, states that nitrogen is mainly present in the interstitial position of a material, but sometimes segregates on the surface of fine particles.

Further, considering the broadness of the term "particles," an aggregate of the nitride particles adjacent to platinum particles may form a conglomeration of the particles to read on the claims.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Lee whose telephone number is 571-272-8699. The examiner can normally be reached on Monday-Friday 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's trainer, Susy Tsang-Foster can be reached on 571-272-1293. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
SUSYTSANG-FOSTER  
PRIMARY EXAMINER

ckl

Cynthia Lee